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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/302,431	04/30/1999	CHANG-HYI LEE	P55690	6892

7590 01/02/2004

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EXAMINER

LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 01/02/2004

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/302,431

Applicant(s)

LEE ET AL.

Examiner

Benjamin E Lanier

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-7 and 9-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 9-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed 24 July 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the added claims 18-40.

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

2. Applicant's arguments filed 6 November 2003 have been fully considered but they are not persuasive. Applicant's statement that all the main elements and their relationships to one another are adequately described in the amended claims is not responsive as it does not show where the specification, cited by page and line number, reasonably conveys to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant gives no clear description of how content is decrypted, or how it is used. In claim 32, applicant provides no clear connection to the content supplier or other elements of the other independent claims. Further, applicant provides no support for the added claims. Applicant claims that the amendment includes no new matter. Applicant is required to show where support for the amendments to the claims and the subject matter of the added claims is found in the original disclosure, cited by page and line number.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 18-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-3, 5-7, 9-23, 25-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs, U.S. Patent No. 6,574,609. Referring to claims 1-3, 5, 7, 9, 11-23, 25-40, Downs discloses a secure electronic content management system wherein a content supplier contains

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audio content in a database that can be encrypted along with encryption keys to form a packet.

The hosting agents cannot access the decrypted content without clearance from the

Clearinghouse (certificate authority) and notification to the content provider (Col. 9, line – 39 –

Col. 10, line 17), which meets the limitation of a content supplier transmitting a second

registration request signal to the certificate authority, said certificate authority and said content

supplier sharing a first secret channel, said content supplier receiving and storing said first key

information from the certificate authority through said first secret channel for supplying said

encrypted digital content, said content supplier generating and outputting second key information

for giving an authorization to receive and reproduce said encrypted digital content. The

clearinghouse (content authority) provides the licensing authorization and record keeping for all

transactions that relate to the sale and/or permitted use of the content. When the clearinghouse

receives a request for a decryption key for the content from an intermediate or end-user, the

clearinghouse validates the integrity and authenticity of the information in the request, verifies

the request, and distributes the decryption key (Col. 11, lines 7-24), which meets the limitation of

a certificate authority for generating manufacturer key information and generating first key

information for giving an authorization to supply said encrypted digital content. The end user can

be a pc, while the end user application player can be a properly licensed portable consumer

device (second content output means) and can be used to access the content once authorized, and

can request and manage content keys from the clearinghouse (Col. 11, line 54 – Col. 12, line 10),

which meets the limitation of a portable terminal manufactured by said portable terminal supplier

for reproducing said digital content, said portable terminal transferring the imbedded

manufacturer key information to said content supplier through said personal computer to be

verified by said content supplier, said portable terminal and said personal computer sharing a third secret channel for transferring said encrypted content between said portable terminal and said personal computer.

Referring to claim 6, Downs discloses an electronic digital content store (first content output means) that communicates with the content provider to validate content requests and to distribute requested data (Col. 10, lines 19-59).

Referring to claim 10, Downs discloses an randomly generated symmetric key used in the licensing process of the clearinghouse (certificate authority)(Col. 77, lines 5-16).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Downs, U.S. Patent No. 6,574,609, in view of Davis, U.S. Patent No. 6,041,314. Referring to claim 24, Downs discloses a secure electronic content management system. Downs does not disclose using handshaking protocols or elliptic curve based key protocols. Davis discloses a communication system that utilizes handshaking protocols for communications (Col. 4, lines 48-49), and an elliptic curve cryptosystem (Col. 14, lines 19-23). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use handshaking protocols and an elliptic curve cryptosystem because it provides the highest strength-per-bit of any public-key system as taught by Davis (Col. 14, lines 19-23).

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 703-305-7684. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703)305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.




GILBERTO BARRON
SUPERVISORY PATENT EXAMINER
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